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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,006	10/10/2001	David P. Aschenbeck	25019A	8542

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EXAMINER	
WATKINS III, WILLIAM P	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/975,006	ASCHENBECK ET AL.	
	Examiner	Art Unit	
	William P. Watkins III	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) *1-7,11-52,54,56 and 57* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-10, 53 and 55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The benefit claim filed on 30 August 2004, to Ser. No. 09/223,670, was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by:

(1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

2. The amendment filed 30 August 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure is as follows: the incorporation by reference of 09/223,670 is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The examiner notes that the 103 rejection over Miller et al. in view of Vermilion et al. given in section 4 of the office

action mailed 30 April 2004, was improperly applied to claims 10 and 55, in contradiction to the explicit statement in section 2 of the 30 April 2004 office action that the rejection was being withdraw regarding claims 10 and 55 only. The correct claims are rejected below.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 8-9 and 53 are rejected under 35 U.S.C. 103(a) as being obvious over Miller et al. (WO 00/40794) in view of Vermilion et al. (U.S. 5,494,728).

Miller et al. teaches an improved weather ability upper layer in a 60-day test (page 18, lines 10-30). The weather ability is improved by a top coating layer on the top asphalt portion that may cover the entire surface of the top portion of the roofing material (page 9, lines 1-5). The asphalt coating

may contain fillers (page 6, lines 25-30). The coated web is preferably made of glass fibers (page 6, lines 5-10). Vermilion et al. teaches the use of fillers in conventional asphalt roofing material in the 65% weight range (col. 1, lines 25-35). The instant invention claims the use of a coating asphalt with a weather resistant top portion and a filler loading of 30% to 75%. It would have been obvious to one of ordinary skill in the art to make use an amount of filler in the asphalt of Miller et al. in the conventional weight percent amount of 65% in order to have normal performance of the coating because of the teachings of Vermilion that this is an accepted value.

6. Claims 8-10 and 53 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schult (U.S. 4,911,975) in view of Yap et al. (U.S. 6,037,398) and Wilkes (U.S. 4,609,696).

Schult teaches a top coating on a roofing product that gives enhanced weather ability and that is highly reflective of light (col. 2, lines 10-15). The coating may be polyolefin with bitumen and with a level of fillers in the 50% weight range (col. 4, lines 55-60). The top layer may have a thickness of .2 to .25 centimeters (col. 4, line 34). The center portion may be a glass mat and be penetrated by the coating layers (col. 4, lines 40-42, col. 3, lines 45-50). The bottom coating layer may

have a filler loading of 10% to 20% by weight (col. 2, line 27). Yap et al. teach the use of an asphalt with solvent modified with polymer, aluminum flakes and other inert fillers at up to 50% by weight to form a highly reflective asphalt based coating that has good weather ability (col. 1, lines 25-35, col. 2, lines 5-20). Wilkes as prior art teaches the use of asphalt coatings applied either as hot coatings without solvent or as solvent coatings that are applied cold and then hardened by solvent evaporation (col. 1, lines 10-35). The instant invention claims a top coating layer with an increased weather ability and a central glass fabric layer and a bottom coating of different weather ability with the filler loading of the asphalt based coating being in the 30% to 75% weight range. It would have been obvious to one of ordinary skill in the art to select the option of equally thick top and bottom layers with polyolefin/bitumen and asphalt based materials on a glass fiber center mat from the various combinations of options taught by Schult in order to practice the invention of Schult. The average of filler at 50% by weight in the top coating with filler at 20% weight in the bottom coating for layers being of equal thickness would give an average of over 30% weight filler in the total asphalt based coating of the central web, which meets the instant claim language. It further would have been

obvious to have substituted the reflective asphalt of Yap et al. for the polyethylene/bitumen layer of Schult in order to have similar reflectivity and increased weather ability with a lower cost asphalt based material. It also further would have been obvious to substitute a hot melt form of the coating of Schult in view of Yap et al. for the solvent coating of Schult in view of Yap et al. in order to avoid handling solvent in the process of Schult in view of Yap et al. because of the teachings of Wilkes that either solvent based or holt melt based forms of asphalt may be applied depending on process application location and conditions. The increased weather ability of both the upper layer of both Schult and Yap et al. are taken as meeting the instant claim limitation regarding the 60 day test as both references teach increased weather ability over standard roof outer layers and the PTO does not have experimental facilities to determine the actual weather ability of the references. The burden of proof is therefore shifted to applicant (MPEP 2112 and 2113).

7. Applicant's arguments filed 30 August 2004 have been fully considered but they are not persuasive.

Applicant argues that the rejection over Miller et al. in view of Vermilion be withdrawn in view of applicant's claim to

priority of Ser. No. 09/233,670. As applicant's claim has not been accepted, as noted above, the rejection is maintained.

Regarding the rejection over Schult in view of Yap et al. and Wilkes, applicant argues that the bottom layer of Schult fails to pass the 60 day weathering performance test, that Wilkes in nonanalogous are, and that Wilkes teaches away from not using a solvent. Schult teaches in col. 2, lines 15-20 that the addition of the light colored cover layer greatly increases the life of the bitumen web that would normally be limited by solar radiation and weather. The 60-day weathering test of applicant, on page 12 of the instant specification, is described as 60 cycles of alternating U.V. light and condensation designed to simulate accelerated weathering. As Schult describes a shortened life of the bitumen, when unprotected and exposed to solar radiation, which includes U.V. light, and the accelerated test of applicant is designed to provide a desirable degree of bitumen life, the position of the examiner is that a fair inference can be drawn that the bottom layer material of Schult will not pass the 60 day test. A fair inference being drawn, the burden of proof is shifted to applicant as noted in the above rejection. Regarding Wilkes not being analogous art, Wilkes is mentioned as prior art in Yap et al., which is a roofing reference (col. 1, lines 15-20 of Yap et al.). The

invention of Wilkes is drawn to asphalt with solvent, however asphalt without solvent is discussed as a prior art option. As Schult teaches asphalt without an explicit solvent, one would not be taught away from using the molten asphalt prior art option of Wilkes, when the references are read together as a whole.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The

examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WW/ww
November 12, 2004

WILLIAM P. WATKINS III
PRIMARY EXAMINER